

### REMARKS

The specification has been amended to include a paragraph to refer to related applications. Applicants' priority claim is discussed further below. No new matter has been added.

Claims 51-55 are pending in the present application. Applicants respectfully request reconsideration of the claims in view of the amended specification and the following remarks.

#### The Benefit of the Priority Date of an Earlier Filed Application

After reiterating the information provided on Applicants' data sheet, the Examiner makes the following remarks concerning Applicants' priority claim (Office Action at page 2):

35 U.S.C. 120 states that in order for an application to receive the benefit of the filing date of a previously filed application, the application must be filed **before** the patenting or abandonment of the first application. U.S. application no. 08/273,402 issued as patent no. 5,958,403 on Sept. 28, 1999. The instant application was not filed until March 12, 2001, more than a year after the issue date of the 5,958,403 patent. Thus, this application is denied benefit of the filing date of parent applications. The effective filing date of the instant application is therefore the actual filing date of the application, March 12, 2001.

The Examiner then goes on to reject the claims in the present application for lack of novelty in view of Applicants' own issued patent (U.S. Patent No. 5,958,403; herein, "the '403 patent"), mentioned above. The Examiner's remarks concerning novelty follow.

#### 35 U.S.C. § 102

Claims 51-55 were rejected, as noted above, as being anticipated by the '403 patent. Given the information provided on Applicants' data sheet, the Examiner has denied the benefit of priority to the application which resulted in the '403 patent. Without the benefit of the earlier filing date, the Examiner considers the '403 patent prior art and, therefore, argues (Office action at pages 3-4):

The specification of the '403 patent and the instant application are identical. Columns 3-4 in particular teach methods for inhibiting rejection of a transplanted tissue in a mammal, involving introducing into a cell, either *in vivo* or *ex vivo*, DNA encoding an immunosuppressive protein such that the cell expresses the immunosuppressive protein ('403, column 3, lines 59-62). The specification further teaches that when the DNA is introduced into cells *ex vivo*, the method further includes the transplantation of those cells into the mammal ('403,

column 3, lines 63-65). In column 4, the specification teaches that the cells can be allogeneic or xenogeneic and that the immunosuppressive protein can be IL-10 or TGF- $\beta$  ('403, column 4, lines 12-15, and 41-46). Examples of DNA constructs encoding either IL-10 or TGF- $\beta$  useful for the instant methods are disclosed in column 18, lines 27-62). Thus, by teaching all the limitations of the claims as written, the '403 patent anticipates the instant invention.

In response, Applicants submit that the priority information provided on the data sheet is incomplete. Applicants failed to claim priority to U.S.S.N. 09/304,755, which is the parent of the present application and the child of the '402 application. The '755 application was complete and pending at the time the present application was filed, and Applicants failure to refer to the '755 application on their data sheet was an inadvertent error. To correct that error, Applicants have filed a Petition to Correct an Unintentionally Delayed Claim of Domestic Priority (a copy of which is enclosed with the present Response). Once that Petition is granted, the instant application will be entitled to the benefit of the filing date of the '402 application, and the present ground for rejection will be moot.

#### CONCLUSION

Applicants submit they have taken the proper procedural steps to establish that the present application is entitled to the benefit of the filing date of the '402 application. Should the Examiner believe any further action is necessary at this stage of prosecution, Applicants respectfully request the favor of a telephone call to their representative at the number shown below.

As the amendment to the specification constitutes only the addition of new text, rather than the change of existing text, no "marked-up version" of the new paragraph is shown.

Applicant: Terry B. Strom *et al.*

Serial No.: 09/804,717

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Attorney's Docket No.: 13985-004003

Enclosed is a Petition for a Two-Month Extension of Time, with the required fee. If there are any other charges, or any credits, please apply them to Deposit Account No. 06-1050, referencing Attorney Docket No. 13985-004003.

Respectfully submitted,



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**Version with markings to show changes made**

**In the specification:**

The paragraph beginning on page 1, line 3, has been amended as follows:

**-- RELATED APPLICATIONS**

This application is a continuation (and claims the benefit of priority under 35 USC § 120) of U.S. Application Serial No. 09/304,755, filed May 4, 1999 (now abandoned), which is a continuation of U.S. Application Serial No. 08/273,402, filed July 11, 1994 (now issued as U.S. Patent No. 5,958,403), which is a continuation-in-part of U.S. Application Serial No. 08/024,569, filed March 1, 1993 (now abandoned), which is a continuation-in-part of U.S. Application Serial No. 07/843,731, filed February 28, 1992 (now abandoned). The contents of all the previously filed applications listed here are incorporated herein by reference in their entirety. [continuation-in-part of pending U.S. patent application Serial. No. 08/024,569, filed March 1, 1993 by Terry Strom, Vicki E. Rubin-Kelley, Towia Libermann entitled "Methods and Compounds for Prevention of Graft Rejection"; which is a continuation-in-part of U.S. patent application Serial NO. 07/843,731, filed February 28, 1992, now abandoned.]--